

REMARKS / ARGUMENTS

Reconsideration of the application as amended is respectfully requested.

The examiner objected to the drawings for noting element 49 and for failing to note element 14a. The specification has been amended to delete the reference of element 14a. Figures 1, 2 and 3 have been amended to comply with 37 C.F.R. § 1.83(a). Figure 1 deletes the reference to element 49. Figure 1 also adds reference elements 35 and 36, which refer to a front leg 35, and a back leg 36, respectively. Figure 2 adds reference element 35. Figure 3 adds reference elements 14, 22, 24 and 40, which have been previously disclosed in the description and Figures 1 and 2.

The examiner objected to an alleged spelling error of "lense" on page 5, line 17. The sentence was previously awkward. The specification has been amended to read more coherently.

The examiner rejected Claims 2-7 under 35 U.S.C. § 112, second paragraph, for being indefinite. Claims 2-4 have been amended to overcome the examiner's rejections, wherein "linear carousel" was amended to "linear slide advancement mechanism." Claims 5-7 have been canceled without prejudice, and the content of Claims 5-7 incorporated into New Claims 8-10.

New Claim 8 is an amended version of canceled Claim 6. Claim 6 was rejecting as falling with the parent claim, despite the fact that Claim 1 was not rejected under 35 U.S.C. § 112, second paragraph. Claim 5 depended from Claim 4; Claim 6 depended from Claim 1. Claim 6 should have been Claim 5, and Claim 5 should have been Claim 6, thus Claims 5, 6 and 7 were canceled, and renumber and reordered as Claims 8, 9 and 10.

The examiner respectfully rejected Claims 1-4 and 6 under 35 U.S.C. § 103(a) as being

unpatentable over Besancenot ('470) and in view of Laizans et al. ('262). Claim 6 was canceled without prejudice and the bulk of the content of Claim 6 incorporated into New Claim 8, therefore, the following remarks and arguments as concerning canceled Claim 6 will be directed to New Claim 8.

Several differences exist between Besancenot and the present invention. Besancenot fails to disclose the combination of a portable slide projector having a linear slide advancement mechanism wherein individual brackets and springs urge each subsequent slide forward toward a projection means. Besancenot also fails to disclose a lamp which pivots from behind a slide to the side so that the slide advancement mechanism may urge the next slide forward. Laizans et al. discloses a tapered projector, having a wide rear portion and a more narrow front portion. Thus, the examiner's rejection of Claims 1-4 and 6 is inappropriate, and as such, Claims 1-4 and New Claim 8 should be in a condition for allowance.

The examiner respectfully rejected Claims 5 and 7 under 35 U.S.C. § 103(a) as being unpatentable over Besancenot, in view of Laizans et al. and in further view of LiDonnici et al. Claims 5 and 7 were canceled without prejudice, and the bulk of the content of the Claims 5 and 7 are incorporated into New Claims 9 and 10, respectively.

The differences between the present invention and Besancenot and Laizans et al. have been noted above.

LiDinnici et al. fails to disclose an access door which opens in a clam-shell fashion and provides access to entire interior cavity of the housing. Thus, the combination of LiDinnici et al. to the other references does not render Claims 5 and 7 obvious, therefore New Claims 9 and 10

should be in a condition for allowance.

Based upon the above arguments, it is felt that the differences between the present invention and all of these references are such that rejection based upon 35 U.S.C. § 103(a), in addition to any other art, relevant or not, is also inappropriate. However, by way of additional argument applicant wishes to point out that it is well established at law that for a proper *prima facie* rejection of a claimed invention based upon obviousness under 35 U.S.C. § 103(a), the cited references must teach every element of the claimed invention. Further, if a combination is cited in support of a rejection, there must be some affirmative teaching in the prior art to make the proposed combination. See Orthopedic Equipment Company, Inc. et al. v. United States, 217 USPQ 193, 199 (Fed. Cir. 1983), wherein the Federal Circuit decreed, "Monday Morning Quarter Backing is quite improper when resolving the question of obviousness." Also, when determining the scope of teaching of a prior art reference, the Federal Circuit has declared:

"[t]he mere fact that the prior art could be so modified should not have made the modification obvious unless the prior art suggested the desirability of the modification." (Emphasis added). In re Gordon, 221 USPQ 1125, 1127 (Fed. Cir. 1984).

There is no suggestion as to the desirability of any modification of the references to describe the present invention. An analysis of the disclosures within the cited references fails to cite every element of the claimed invention. When the prior art references require a selective combination to render obvious a subsequent claimed invention, there must be some reason for the selected combination other than the hindsight obtained from the claimed invention itself. Interconnect Planning Corp v. Feil, 774 F.2d 1132, 227 USPQ 543 (CAFC 1985). There is

nothing in the prior art or the Examiners arguments that would suggest the desirability or obviousness of making a portable slide projector having a tubular housing, a linear slide advancement mechanism with a plurality of brackets and springs for advancing single slides.

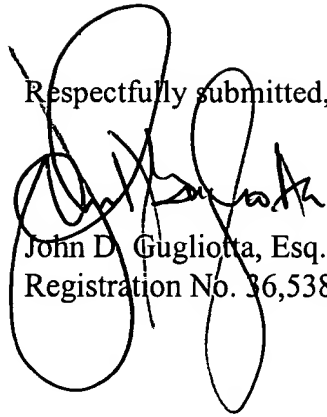
Uniroyal, Inc. v. Rudkki-Wiley Corp., 837 F.2d 1044, 5 USPQ 2d 1432 (CAFC 1988). The examiner seems to suggest that it would be obvious for one of ordinary skill to attempt to produce the currently disclosed invention. However, there must be a reason or suggestion in the art for selecting the design, other than the knowledge learned from the present disclosure. In re Dow Chemical Co., 837 F.2d 469, 5 USPQ.2d 1529 (CAFC 1988); see also In re O'Farrell, 853 F.2d 894, 7 USPQ 2d 1673 (CAFC 1988).

To summarize, it appears that only in hindsight does it appear obvious to one of ordinary skill in the pertinent art to combine the present claimed and disclosed combination of elements. To reject the present application as a combination of old elements leads to an improper analysis of the claimed invention by its parts, and instead of by its whole as required by statute. Custom Accessories Inc. v. Jeffery-Allan Industries, Inc., 807 F.2d 955, 1 USPQ 2d 1197 (CAFC 1986); In re Wright, 848 F.2d 1216, 6 USPQ 2d 1959 (CAFC 1988).

Therefore, in view of foregoing amendments and clarifications, the applicant submits that allowance of the present application and all remaining claims, as amended, is in order and is requested.

Utility Patent
Ser. No. 09/758,097

Respectfully submitted,

A handwritten signature in black ink, appearing to read 'John D. Gugliotta', is written over the printed name and registration number.

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VERSION WITH MARKINGS TO SHOW CHANGES MADE

In the Drawings

In accordance with 37 C.F.R. § 1.123, a separate request for correction of drawings has been submitted in conjunction with this amendment. As required by 35 U.S.C. § 132 and 37 C.F.R. § 1.118, care has been exercised to avoid introduction of anything which could be construed to be new matter.

In the Specification

Three paragraphs comprising the “Detailed Description of the Figures”, beginning on page 5, line 2, and concluding on page 6, line 6, has been amended as follows:

1. Detailed Description of the Figures

Referring now to FIG. 1, a portable projector 10 including a linear [carousel] slide advancement mechanism 12 for retaining a plurality of otherwise conventional projector slides 14. The linear carousel mechanism 12 includes a guide rail 16 that guides and articulates a plurality of slide gripping brackets 18 that are spring urged by a slide advance spring 20 tracked between each respective gripping bracket 18 along the guide rail 16. Each respective slide 14 is articulated and urged forward toward a projector lamp 22 near a projection lens means 24 toward the front of a housing 30. A housing access door 32 is pivotally affixed to the housing 30 such as to open in a clam-shell type manner to provide access to the housing internal cavity. The

housing 30 further includes a front leg 35, affixed at an exterior front portion of the housing 30, and a back leg 36, opposite to the front leg 35 and affixed at an exterior back portion of the housing 36. The front leg 35 is adjustable so as to accommodate different surfaces upon which the projector 10 might rest or to accommodate angled viewing.

Referring to FIG. 2, the exterior of the housing 30 of the portable projector 10 is shown in greater detail. The housing 30 has an overall size, shape and function of a flashlight. A rechargeable battery pack 34 in the rear of the housing provides power to the projection lamp [assembly] 22 as controlled through a switch 38. Various fixed lenses, as well as an adjustable focusing lense 40, [then] allows the image of the slide to be projected onto any flat surface.

FIG. 3 shows in detail the placement of the projection lamp 22 relative to the slides 14. The projection lamp [assembly 24] 22 is pivotally articulated to the rail [12] 16 in such a manner that it can be pivoted up into position between the lead slide 14 and the next available slide in the [carousel] slide advancement mechanism 12. In this manner, the lamp can cast the image on the slide toward the [lens assembly] projection lens means 24 for projection. As the lamp assembly [24] 22 is pivoted out of the linear track of the slides, a new slide is urged forward by spring action and the old slide is discharged. It is anticipated that the discharged slide [14a] will then be returned to the carousel at the end of the [track] slide advancement mechanism 12.

In the Claims

Claims 1-3 have been amended.

Claim 4 is not/amended.

Claims 5-7 have been canceled without prejudice.

Claims 8-14 are newly added claims. New Claim 8 is canceled Claim 6. New Claim 9 is canceled Claim 5. New Claim 10 is canceled Claim 7.

Please amend the following claims by deleting the language which is enclosed in brackets "[]" and inserting the language which is underlined "_____".

1. (Twice Amended) A portable projector comprising:

a housing having a generally tubular[, portable] shape, wherein the overall size and shape of said portable projector is of a conventional flashlight; and

slide projection means mounted within said housing for projecting a slide image from a lens mounted on an anterior end of said housing;

wherein said slide image is loaded onto currently available, conventional projection slide medium.

2. (Twice Amended) The portable projector of Claim 1, wherein said slide projection means comprises a linear [carousel] slide advancement mechanism for retaining a plurality of projector slides.

3. (Amended) The portable projector of Claim 2, wherein said linear [carousel] slide advancement mechanism includes a guide rail that guides and articulates a plurality of slide gripping brackets that are spring urged by a slide advance spring tracked between each of said respective gripping brackets along said guide rail.

5. Canceled.

6. Canceled.

7. Canceled.

8. (New) The portable projector of Claim 4, wherein said lamp assembly is pivotally articulated to said rail in such a manner that it can be pivoted up into position between a lead slide and a next available slide in said slide advancement mechanism, and as a new slide is urged forward by spring action an old slide is discharged.

9. (New) The portable projector of claim 1, wherein said housing further comprises an access door pivotally affixed to said housing such as to open in a clam-shell type manner to provide access to a housing internal cavity.

10. (New) A slide projector comprising:

- a linear slide advancement mechanism for retaining a plurality of projector slides;
- a guide rail aligned with said linear slide advancement mechanism that guides and articulates said plurality of slide gripping brackets;
- a plurality of slide advance spring, each said advance spring tracked between each respective gripping bracket along said guide rail, wherein each respective slide is articulated and urged forward toward a projector lamp;
- projection lens means toward the front of a housing; and
- a housing access door pivotally affixed to said housing such as to open to provide access to a housing internal cavity.

11. (New) A slide projector comprising:

- a housing, said housing having a generally tubular shape, said housing sized to provide portability to said slide projector;
- a housing access door, said door pivotally affixed to said housing, thereby providing access to an internal cavity formed within said housing;
- an on/off switch, said switch positioned on a top surface of said housing;
- a linear slide advancement mechanism, said advancement mechanism affixed within said housing and accessible through said door, said advancement mechanism comprising a guide rail;
- a plurality of slide gripping brackets, said brackets integral with said advancement mechanism, each said bracket supporting a slide in a vertical orientation;

a plurality of slide advancement springs, each said spring urges each respective said bracket forward and stimulates discharge of a previously transmitted slide;

a projector lamp, said lamp pivotally articulated to said guide rail, said lamp resiliently deformed upon advancement of each said slide;

projection means, said projection means affixed to a front of said housing, said projection means transmits image of said slide through an adjustable focusing lens; and

a rechargeable battery pack, said battery pack position at a rear of said housing, said battery pack providing electrical power to said projector when activated by said on/off switch.

12. (New) The slide projector of Claim 11 further comprising a pair of legs for supporting said slide projector.

13. (New) The slide projector of Claim 12, wherein said pair of legs comprises:

a front leg, said front leg affixed to an exterior front portion of said housing; and

a back leg, said back leg affixed to an exterior rear portion of said housing, said back leg opposite to said front leg.

14. (New) The slide projector of Claim 13, wherein said front leg is adjustable, thereby providing for varying support surfaces of said slide projector.